

REMARKS

Claims 1-25 are pending in the present application. Claims 2, 4 and 15 were amended in this response. Claims 1, 15 and 21 are independent claims. No new matter was added as a result of these amendments.

Applicants wish to note that, in the applicant's IDS considered on 8/10/04, reference WO 97/16938 was submitted for consideration, but was incorrectly referenced on the IDS form as WO 97/16948. Applicants kindly request confirmation that the proper documents were reviewed and acknowledged by the Examiner.

Claims 2, 4 and 15-20 were rejected under 35 U.S.C. §112, second paragraph as being indefinite for failing to point out and distinctly claim the subject matter which Applicant regards as the invention. In light of the present amendments, Applicant submits the rejected matter has been addressed. Withdrawal of the rejection is earnestly requested.

Claims 1-4, 14, 21, 22 and 24 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Kobata* (US Patent 6,058,418) in view of *Nakagawa et al.* (US Patent 5,838,911).

Claims 5 and 6 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Kobata* (US Patent 6,058,418) in view of *Nakagawa et al.* (US Patent 5,838,911) and further in view of *Chen et al.* (US Patent 5,797,016)

Claims 7, 12, 13 and 23 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Kobata* (US Patent 6,058,418) in view of *Nakagawa et al.* (US Patent 5,838,911) and further in view of *Valentine* (US Patent 6,018,654).

Claim 8 was rejected under 35 U.S.C. §103(a) as being unpatentable over *Kobata* (US Patent 6,058,418) in view of *Nakagawa et al.* (US Patent 5,838,911) and further in view of *Pepe et al.* (US Patent No 5,742,668).

Claims 9-11 and 25 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Kobata* (US Patent 6,058,418) in view of *Nakagawa et al.* (US Patent 5,838,911) and further in view of *Shear* (US Patent No 4,977,594).

Claims 15 and 17 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Kobata* (US Patent 6,058,418) in view of *Shah* (US Patent 6,029,065) and further in view of

Nakagawa et al. (US Patent 5,838,911). Applicant traverses these rejections. Favorable reconsideration is respectfully requested.

According to independent claims 1, 15 and 21, a telecommunication network and method is recited having a central server of an access or service provider and a plurality of terminal devices of users, each having a predetermined hardware and software configuration. In contrast, *Kobata* describes an Internet based client/server application, where the server application records client's demographic information including CPU power, log-in history, etc. to forward to the Internet service provider (col. 2, line 66 - col. 3, line 4). In the system of *Kobata*, clients transfer data relating to client infrastructure to the server by means of client software. The corresponding data transfer is thus initiated on the client side (col 3, lines 6-9 and col. 3, lines 52-60).

However, the present claims recite an interrogating part for interrogating the hardware and software configurations of the terminal device and a software transmitting part for loading software and/or data that has been adapted to the hardware and software configuration so determined onto the terminal devices (see claims 1 and 15; claim 21: "transmitting a configuration code"). The interrogation of the hardware and software configurations of the terminal devices is initiated by the server - i.e., the server determines whether and at what times the hardware and software configurations of the terminal devices are interrogated. The terminal devices of the present claims also comprise a response transmitting part for transmitting a configuration code representing the hardware and software configuration to the server in response to a query sent by the interrogating part and a software receiving part for receiving and internally storing transmitted software and data. Such a configuration is not disclosed in *Kobata*.

Furthermore, the present claims recited that the transmission occurs in response to a query from the interrogating part of the server. As explained above, no such interrogating means are provided for the server according to *Kobata*, since a client/server architecture is provided, and the clients perform an information transfer to the server on the basis of the client software running on them. The Office Action has conceded that *Kobata* fails to teach the recited control parts of the present claims.

Regarding *Nakagawa*, the reference relates to a system and a method for distributing and maintaining software, as opposed to demographic marketing data, disclosed in *Kobata*. *Nakagawa* provides for a client/server system in which a client program in a user's computer

directs a query to a software provider's server over a network. Information about the current software version is requested in the query (Abstract, col. 1, lines 13-19 and col. 8, lines 26-36). *Nakagawa*, teaches that the seller specifies an "access qualification level" of the respective customer on the server side (column 67, lines 50-60). The customer is then offered various functionalities on the basis of the customer's access qualification level. When the seller specifies the access qualification level on the server, the seller specifies whether or not the customer or user has to pay in advance (i.e. which payment method is available to the customer - column 67, lines 39-48). Thus, the access qualification levels in *Nakagawa* are a matter of rights for the respective user that are defined only by the seller on the server, as opposed to the server and the terminal devices. The system described by *Nakagawa* contains no distributed control means that are arranged in both the server and the client. Interactive control of the software transmission is controlled on the server side exclusively.

Furthermore, *Nakagawa* teaches that the payment method available to each user is specified in a customer database on the server side (column 67, lines 62-67 and column 68, lines 17-29). Only those purchase orders which contain the payment method specified for the respective user are acknowledged. In contrast, the present claims recited that the distributed control means enable the interactive determination of a charging mode for downloading software and/or data. Such an interactive determination of a charging mode does not take place in the system and method disclosed in *Nakagawa*, which explicitly discloses that the payment method for an individual user is unilaterally and permanently specified by the seller in the seller's database (i.e., there is no interaction with the client in this regard). For the foregoing reasons, the rejection under 35 U.S.C. §103 are improper and should be withdrawn..

Furthermore, Applicants submit that there is no teaching, suggestion or motivation for one of ordinary skill in the art to combine the *Kobata/Nakagawa* and *Kobata/Shah* references in the manner suggested in the Office Action. In making a determination that an invention is obvious, the Patent Office has the initial burden of establishing a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S. P.Q.2d 1955, 1956 (Fed. Cir. 1993). "If the examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent." *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986). (see MPEP 2142).

Further, the Federal Circuit has held that it is "impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992). "One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention" *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Moreover, the Federal Circuit has held that "obvious to try" is not the proper standard under 35 U.S.C. §103. *Ex parte Goldgaber*, 41 U.S.P.Q.2d 1172, 1177 (Fed. Cir. 1996). "An-obvious-to-try situation exists when a general disclosure may pique the scientist curiosity, such that further investigation might be done as a result of the disclosure, but the disclosure itself does not contain a sufficient teaching of how to obtain the desired result, or that the claim result would be obtained if certain directions were pursued." *In re Eli Lilly and Co.*, 14 U.S.P.Q.2d 1741, 1743 (Fed. Cir. 1990).

Regarding *Kobata/Nakagawa*, it was pointed out that in *Kobata*, a transfer of information to the server takes place which is initiated on the client side. In contrast, *Nakagawa* teaches that the transfer is initiated exclusively from the server side. As such, there is no teaching, suggestion or motivation for one having ordinary skill in the art to combine these references as suggested in the Office Action. Furthermore, regarding the Shah reference, the disclosure does not even contemplate the use of a central server (argued previously in the Office Action dated

January 10, 2005; see also arguments regarding *Chen*, *Valentine* and *Pepe*). As such, Applicants submit the rejections are improper and should be withdrawn.

In light of the above amendments and arguments, Applicant submits that the present claims are allowable over the prior art. Withdrawal of the rejections under 35 U.S.C. §102 and §103 are respectfully requested. Applicant also requests that a timely Notice of Allowance be issued in this case. Should there be any additional charges regarding this application, the Examiner is hereby authorized to charge Deposit Account 02-1818 for any insufficiency of payment.

Respectfully submitted,

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